



Attorney Docket # 22/HG

**IN THE UNITED STATES PATENT
AND TRADEMARK OFFICE**

Applicants : Masato NAGAOKA et al.
Serial No. : 09/806,650
Filed : April 2, 2001
For : ANTIBACTERIAL AGENTS AND
PROCESS FOR PRODUCING THE
SAME
Art Unit : 1623
Examiner : L.C. MAIER

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

S I R :

This is a response to the Office Action of September 18, 2002, which is a Restriction Requirement under 35 USC 121 and 372. The one-month term for responding is being extended five months until March 18, 2003 by a PETITION FOR EXTENSION OF TIME filed currently herewith.

Restriction was required between:

"Group I, claims 1-3 and 7, drawn to antibacterial agents;

Group II, claims 4 and 5, drawn to methods of treating H. Pylori or gastric ulcer; and

Group III, claim 6, drawn to method of preparing antibacterial agents."

CERTIFICATE OF MAILING

I hereby certify this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class mail in an envelope addressed to:
Commissioner for Patents,
Washington, D.C. 20231 on the date noted below.

Attorney: HERBERT GOODMAN

Dated: MARCH 14, 2003

In the event that this Paper is late filed, and the necessary petition for extension of time is not filed concurrently herewith, please consider this as a Petition for the requisite extension of time, and to the extent not tendered by check attached hereto, authorization to charge the extension fee, or any other fee required in connection with this Paper, to Account No. 06-1378.

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The Restriction Requirement is respectfully traversed, as explained hereinafter. Subject to said traverse, Group I is provisionally elected.


The first paragraph on page 3 of the Office Action notes that claims 4 and 5 "are technically written as composition claims" and that if these claims "are indeed meant to be composition claims", these claims would be considered part of Group I. These claims are expressly written as composition claims and are intended to be composition claims. It follows that in accordance with the statements in the first paragraph on page 3 of the Office Action, these claims should be examined together with the claims identified as Group I.

Non-elected claim 6 is directed to a method for producing an antibacterial agent as set forth in claim 1. Accordingly, when product claims are found allowable, the process of making the claim product is also allowable and should be rejoined and allowed together with the product claims (see attached copy of Commissioner's Notice "Guidance on Treatment of Product and Process Claims in light of In re Ochiai, In re Brouwer and 35 U.S.C. §103(b)", dated February 28, 1995.

Reconsideration of the Restriction Requirement is requested.

Respectfully submitted,

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Encs.: PETITION FOR EXTENSION OF TIME;
Copy of PTO NOTICE ON TREATMENT
OF PRODUCT AND PROCESS CLAIMS

two-dimensional images which alone are surface ornamentation. See, e.g., *Ex parte Stripland*, 26 USPQ2d 1259, 1262 (Bd. Pat. App. & Int. 1992) (computer-generated icon alone is merely surface ornamentation).

3. Since a patentable "design is inseparable from the object to which it is applied and cannot exist alone merely as a scheme of surface ornamentation," a computer-generated icon must be embodied in a computer screen, monitor, other display panel, or portion thereof, to satisfy section 171. MPEP 1502: 1504.01.A.

4. "We do not see that the dependence of the existence of a design on something outside itself is a reason for holding it is not a design 'for an article of manufacture.'" *In re Hruby*, 153 USPQ 61, 66 (CCPA 1967) (design of water fountain patentable design

for an article of manufacture). The dependence of a computer-generated icon on a central processing unit and computer program for its existence itself is not a reason for holding that the design is not for an article of manufacture.

5. Since the claim must be in formal terms to the design "as shown, or as shown and described," the drawing provides the best description of the claim. 37 CFR 1.151.

6. Although a computer-generated icon may be embodied in only a portion of a computer screen, monitor, or other display panel, the drawing "must contain a sufficient number of views to constitute a complete disclosure of the appearance of the article." 37 CFR 1.152. In addition, the drawing must comply with 37 CFR 1.84.

7. The following titles do not adequately

describe a design for an article of manufacture under section 171: "computer icon;" or "icon." On the other hand, the following titles do adequately describe a design for an article of manufacture under section 171: "computer screen with an icon;" "display panel with a computer icon;" "portion of a computer screen with an icon image;" "portion of a display panel with a computer icon image;" or "portion of a monitor displayed with a computer icon image."

8. See *McGrady v. Aspenglas Corp.*, 487 F. Supp. 859, 861, 208 USPQ 242, 244 (S.D.N.Y. 1980) (descriptive statement in design patent application narrows claim scope).

9. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)

PTO NOTICE ON TREATMENT OF PRODUCT AND PROCESS CLAIMS

Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. §103(b)

The purpose of this Notice is to provide guidance to Patent and Trademark Office personnel and to the public on the proper consideration of certain claims in light of *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, "F.3d", 37 USPQ2d 1663 (Fed. Cir. 1996) and the passage of 35 U.S.C. §103(b), which became effective November 1, 1995. *Ochiai*, *Brouwer* and §103(b) relate to how process claims directed to making or using nonobvious products are to be treated.

The Court in *Ochiai* and *Brouwer* addressed the issue of whether an otherwise conventional process could be patented if it were limited to making or using a nonobvious product. In both cases, the Federal Circuit held that the use of per se rules is improper in applying the test for obviousness under the 35 U.S.C. §103. Rather, §103 requires a highly fact-dependent analysis involving taking the claimed subject matter as a whole and comparing it to the prior art. To support a rejection under §103, the collective teachings of the prior art must have suggested to one of ordinary skill in the art that, at the time the invention was made, applicant's claimed invention would have been obvious. In applying this test to the claims on appeal, the Court held that there simply was no suggestion or motivation in the prior art to make or use the nonobvious products to which the claims were limited and consequently overturned the rejections based upon §103.

Interpreting a claimed invention as a whole requires consideration of all claim limitations. Thus, language in a process claim which recites making or using a nonobvious product must be treated as a material limitation, and a motivation to make or use the nonobvious product must be present in the prior art for a §103 rejection to be sustained.

In light of *Ochiai* and *Brouwer*, Office personnel will consider all claim limitations when analyzing process claims which make or use nonobvious products under §103. Office personnel will focus on treating claims as a whole and follow the analysis set forth in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).

Accordingly, to facilitate examination under §103, where product and process claims are presented in the same application, applicant may be called upon under 35 U.S.C. §121 to elect claims to either the product or process. The claims to the non-elected invention will be withdrawn from further consideration. However, in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim. Withdrawn process claims not commensurate in scope with an allowed product claim will not be rejoined. In the event of rejoinder, the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104-1.106. If the application containing the rejoined claims is not in condition for allowance, the subsequent Office action may be made final, or, if the application was already under final rejection, the next Office action may be an advisory action.

35 U.S.C. §103(b) is applicable to biotechnological processes only. Section 103(b) precludes a rejection of process claims which involve the use or making of certain nonobvious biotechnological compositions of matter under §103(a). Section 103(b) requires that:

1. the biotechnological process and composition of matter be contained in either the same application or in separate applications having the same effective filing date;
2. both the biotechnological process and composition of matter be owned or subject to an assignment to the same person at the time the process was invented;

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3. a patent issued on the process also contain the claims to the composition of matter used in or made by the process, or, if the process and composition of matter are in different patents, the patents expire on the same date;
4. the biotechnological process falls within the definition set forth in §103(b); and;
5. a timely election be made to proceed under the provisions of §103(b).

In view of the Federal Circuit's decisions in *Ochiai* and *Brouwer*, an applicant's need to rely upon §103(b) should be rare. Consequently, the Patent and Trademark Office will treat §103(b) elections on a case-by-case basis by way of petition under 37 CFR 1.182. That petition must establish that all the requirements set forth in §103(b) have been satisfied. An election will normally be considered timely if it is made no later than the earlier of either (1) the payment of the issue fee, or (2) the filing of an appeal brief in an application which contains a composition of matter claim which has not been rejected under 35 U.S.C. §§102 or 103.

In an application where at least one composition of matter claim has not been rejected under 35 U.S.C. §§102 or 103, a §103(b) election may be made by submitting the petition and an amendment requesting entry of process claims which correspond to the composition of matter claim.

For applications pending on or after November 1, 1995, in which the issue fee has been paid prior to the date of this Notice, the timeliness requirement for an election under §103(b) will be considered satisfied if the conditions of 37 CFR 1.312(b) are met. However, if a patent is granted on an application entitled to the benefit of §103(b) without an election having been made as a result of error without deceptive intent, patentees may file a reissue application to permit consideration of process claims which qualify for §103(b) treatment.

Any questions, comments or suggestions regarding petitions under 37 CFR 1.182 filed pursuant to this Notice should be directed to the Special Program Law Office, attention: Hiram Bernstein, Senior Legal Advisor. All other questions, comments or suggestions regarding this Notice should be directed to the Solicitor's Office, attention: Craig Kaufman, Associate Solicitor.

February 28, 1995
Bruce A. Lehman
Assistant Secretary of Commerce and
Commissioner of Patents and Trademarks
www.uspto.gov
Last Modified: 5 March 1996